



04-09-04

Op 1762

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent Application of:

Applicant: BAUM, Thomas H., et al.

Application No.: 10/008,980

Date Filed: December 6, 2001

Title: METHOD OF FABRICATING
IRIDIUM-BASED
MATERIALS AND
STRUCTURES ON
SUBSTRATES

Docket No.: 2771-260 CIP DIV
RCE (7482)

Examiner: TALBOT, Brian
K.

Art Unit: 1762

Confirmation No.: 5984

Customer No.: 25559

EXPRESS MAIL CERTIFICATE

I hereby certify that I am mailing the attached documents to the Commissioner for Patents on the date specified, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, and Express Mailed under the provisions of 37 CFR 1.10.


L. Stephen Lockett

April 8, 2004
Date

EO001694856US
Express Mail Label Number

**DEMAND FOR RESCISSION OF APRIL 5, 2004 NOTICE OF NON-COMPLIANT
AMENDMENT IN UNITED STATES PATENT APPLICATION NO. 10/008,980, ON BASIS
THAT DECEMBER 29, 2003 AMENDMENT IS IN COMPLIANCE WITH 37 CFR §1.121**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This responds to the April 5, 2004 Notice of Non-Compliant Amendment (37 CFR §1.121) issued by the Legal Instruments Examiner, Wanda Mitchell, holding the December 29, 2003 amendment to be non-compliant in respect of the requirements of 37 CFR §1.121.

Specifically, the Examiner had stated that such amendment was non-compliant because:

“Claims 30 and 31 missing from Amdt, to be entered w/ R.C.E. filed 3/26/04.”

In reply, it is pointed out that the instant application was filed on December 6, 2001 with claims 1-29 and 32. The claims on page 28 of the application included claim 29 followed by claim 32. No claim 30 and no claim 31 were ever present in the application.

The application was thereafter prosecuted for over two years, during which time the absence of claims 30 and 31 was not objected to, since the application in the first instance had not contained any such claims 30 and 31.

Thus, the amendment filed December 29, 2003 in the application is fully accurate, consistent with the record, and in compliance with the provisions of 37 CFR §1.121.

Further, the attention of the Legal Instruments Examiner is directed to the provisions of 37 CFR §1.126 (“Numbering of claims”) which requires that:

“The original numbering of the claims must be preserved throughout the prosecution. When claims are cancelled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.” (emphasis added)

It therefore is evident that the Notice of Non-Compliant Amendment dated April 5, 2004 was issued by the USPTO in error.

Demand therefore is made that such Notice of Non-Compliant Amendment be immediately rescinded, and that the December 29, 2003 amendment be considered in the further examination pursuant to the Request for Continued Examination filed March 26, 2004.

Correspondingly, the USPTO is requested to immediately confirm to the undersigned attorney the fact of its error, with assurance that the Notice of Non-Compliant Amendment has in fact been vacated, and that

the RCE application and December 29, 2003 amendment have been passed to substantive examination on the merits.

Respectfully submitted,



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